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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,313	11/16/1999	ALLAN SVENDSEN	5709.200-US	4161

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EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/441,313

Examiner

Richard G Hutson

Applicant(s)

SVENDSEN ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42 and 44-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 42 and 44-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicants amendment canceling claim 43 and amendment of claims 42, 44, 49, 51, 54, 59, 60 and 61, Paper No. 18, is acknowledged. Claims 42 and 44-61 are at issue and are present for examination.

Applicants' arguments filed on 1/23/2003, Paper No. 18, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### *Specification*

The disclosure is objected to because of the following informalities:

Applicants previous amendment of the specification, Paper No. 12, 2/7/2002, on page 5, lines 21-27, is confusing. Applicants recite "Ala30Asp + Glu34Ser or A30N + E34S representing mutations in positions 30 and 34 substituting alanine and glutamic acid for asparagine and serine...". This recitation appears to be inconsistent with the rest of the application. It is believed that the proper recitation would be "Ala30Asp + Glu34Ser or A30D[N] + E34S representing mutations in positions 30 and 34 substituting **aspartic acid** [alanine] and glutamic acid for **alanine** [asparagines] and serine...". It is suggested that any similarly confusing annotations in the specification also be corrected.

Appropriate correction is required.

***Claim Objections***

Claim 61 is objected to because of the following informalities: Claim 61 is missing a period at the end of the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42 and 44-61 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for DNA sequence encoding an alpha-amylase comprising the amino acid sequence of SEQ ID NO: 4 with an alteration at S356, does not reasonably provide enablement for any DNA sequence encoding an alpha-amylase, said alpha amylase having an amino acid sequence which is at least 60% identical to SEQ ID NO: 4 and having an alteration at a position corresponding to S356, using SEQ ID NO: 4 for numbering. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4)

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the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claims 42 and 44-61 are so broad as to encompass any DNA sequence encoding any alpha-amylase, said alpha amylase having an amino acid sequence which is at least 60% identical to SEQ ID NO: 4 and having an alteration at a position corresponding to S356, using SEQ ID NO: 4 for numbering. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of DNA sequences broadly encompassed by the claims, including all DNA sequences encoding any alpha amylase having a mere 60% amino acid identity to SEQ ID NO: 4 and an alteration at position S356. The claims rejected under this section of U.S.C. 112, first paragraph, are extremely broad and place corresponding broad structural limits on the claimed DNA sequences. Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the proteins' structure relates to its function. However, in this case the disclosure is limited to that DNA sequence encoding an alpha-amylase comprising the amino acid sequence of SEQ ID NO: 4 with an alteration at S356.

While recombinant and mutagenesis techniques are known, it is not routine in the art to screen for multiple substitutions or multiple modifications, as encompassed by the instant claims, and the positions within a protein's sequence where amino acid modifications can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited in any protein and the result of such modifications is unpredictable. In addition, one skilled in the art would expect any tolerance to modification for a given protein to diminish with each further and additional modification, e.g. multiple substitutions.

The specification does not support the broad scope of the claims which encompass all modifications and fragments of any DNA sequence encoding an alpha-amylase comprising the amino acid sequence of SEQ ID NO: 4 with an alteration at S356, because the specification does not establish: (A) regions of the protein structure which may be modified without effecting alpha-amylase activity; (B) the general tolerance of alpha-amylases to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any amino acid residue of any alpha-amylase with an expectation of obtaining the desired biological function; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful. Because of this lack of guidance, the extended experimentation that would be required to determine which substitutions would be acceptable to retain the alpha-amylase activity claimed and the fact that the relationship between the sequence of a peptide and its tertiary structure (i.e. its activity) are not well understood and are not predictable (e.g., see Ngo et al. in *The Protein Folding Problem and Tertiary*

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Structure Prediction, 1994, Merz et al. (ed.), Birkhauser, Boston, MA, pp. 433 and 492-495, Ref: U, Form-892), it would require undue experimentation for one skilled in the art to arrive at the majority of those DNA sequences of the claimed genus.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including any DNA sequence encoding any alpha-amylase, said alpha amylase having an amino acid sequence which is at least 60% identical to SEQ ID NO: 4 and having an alteration at a position corresponding to S356. The scope of the claims must bear a reasonable correlation with the scope of enablement (In re Fisher, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See In re Wands 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir, 1988).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Richard Hutson', followed by a horizontal line.

Richard Hutson, Ph.D.  
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February 11, 2003